



UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087118.019	09/02/93	BEERY	JB2.3

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E3M1/0331

EXAMINER  
FLYNN, M

ART UNIT	PAPER NUMBER
2602	

DATE MAILED: 03/31/97 *23*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.  
**08/116,019**

Applicant(s)

Beery

Examiner

Nathan J. Flynn

Group Art Unit

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Responsive to communication(s) filed on 8-20-96

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 1-5, 7-19, 21-28, and 30-56 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-5, 7-19, 21-28, and 30-56 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 22 19 14

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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***Double Patenting***

1. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent, the possible harassment by multiple assignees, the possibility that one might avoid the effects of file wrapper estoppel by filing a second application. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5, 7-19, 21-28 and 30-56 are rejected under the judicially created doctrine of double patenting over claims 1-18 and 22-39 of U. S. Patent No. 5,068,734 as defined in the corresponding Reexamination Certificate issued on October 26, 1993, since the claims, if allowed, would create the possibility of harassment from multiple assignees.

Applicant has admitted throughout the prosecution of this Reissue application that the subject matter claimed in the instant application is fully disclosed in patent 5,068,734 and is covered by the claims of the patent. The claims in the Reexamination Certificate of patent 5,068,

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734 and the claims of the instant application comprise a tune by label method and apparatus for controlling a television system.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of application 07/359,155, which matured into a patent 5,068,734. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### ***Reissue Declaration Issues***

3. The substitute reissue declaration filed on 4-15-97 for this application is defective because it fails to describe the actual error(s) in the patent, i.e., it fails to particularly specify the "defects" in the specification or drawings, 37 CFR 1.175 (a)(2); and/or it fails to distinctly specify the "excess or insufficiency" in the claims, 37 CFR 1.175(a)(3).

The substitute reissue declaration filed on 4-15-97 for this application is defective because it fails to particularly specify the errors and/or how the errors relied upon arose or occurred as required under 37 CFR 1.175(a)(5). Included are inadvertent errors in conduct, i.e., actions taken by the applicant, the attorney or others, before the original patent issued, which are alleged to be the cause of the actual errors in the patent. This includes how and when the errors in conduct arose or occurred, as well as how and when these errors were discovered. Applicant's

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attention is directed to *Hewlett-Packard v. Bausch & Lomb*, 11 USPQ2d 1750, 1758 (Fed. Cir. 1989).

When filing the original application (07/514,693), Applicant signed a declaration stating that "I have reviewed and understand the contents of the above identified specification, including the claims as filed." Applicant now asserts that at the time of signing this declaration, he did not fully understand invention disclosed in the specification and defined in the claims. Therefore, following errors occurred during the prosecution of Patent 5,045,947:

- A. "I did not realize that my invention also encompassed the method in accordance with which the device operated."
- B. "I over looked the fact that it was not necessary to include the tuning means of the television receiver as an element in the claims, since the device could be constructed as a remote device which relied upon the television's own tuning means."
- C. "I invented various other television control features, among them being a system wherein the operator may selectively assign desired channels in a desired order into a cue or into a scroll sequence, or wherein the operator may assign selected channels into two or more independent cues or scroll sequences for channel selection. However, because I assumed such features would all be incorporated into a single remote control device, these features were claimed

only in combination with the operator-selected channel designation feature. In fact these features should have been also claimed independently”

D. “I also did not utilize certain alternate claim language to that actually used in the claims of the ‘947 and reexamined ‘734 patents.”

E. “I did not claim my invention, with respects to the actions of the processor, using alternate language “in response to” instead of “upon the receipt of” with regards to various input signals to the processors.”

F. “I also erroneously did not claim my invention using alternate language “tuner” for “tuner means”, “memory means” for “memory”, “operator-actuated control device” for “operator-actuated control means”, and “processor” for “processor means”; the alternate language “channel code” for “channel tuning designation” and “select code” for “channel select designation”; and the alternate language wherein the “channel tuning designation” is defined as being “in a first series”, and the “channel select designation” is defined as being in a second series.”

As to alleged error A, Applicant has failed to point out exactly when and how this alleged error arose and was discovered (see MPEP 1414 and 37 CFR 1.175). During the prosecution of the original application, Applicant was represented by a register patent attorney. It is the duty of a patent attorney to ensure that his client receives the broadest patent protection legally available. Applicant has completely failed to address how a registered patent attorney

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failed to realize that the specification supports both method and apparatus claims. Since a method claim is typically broader in scope than its corresponding apparatus claim, seeking protection for both the method and apparatus would have been obvious to a register patent attorney.

Applicant asserts that this error was discovered sometime between January 1993 and August 1993 through discussions with numerous attorneys and by studying the patent and prior art. This 7-month range and general statement is not sufficient to point out how and when the alleged error was discovered.

As to alleged error B, Applicant has failed to point out exactly when and how this alleged error arose, and when and how it was discovered (see MPEP 1414 and 37 CFR 1.175). During the prosecution of the original application Applicant was represented by a register patent attorney. It is the duty of a patent attorney to ensure that his client receives the broadest patent protection legally available. Applicant has completely failed to address how a registered patent attorney failed to realize that the inclusion of the tuning means in the claims was not necessary and that its inclusion unduly narrows the claims.

Applicant asserts that this error was discovered sometime between January 1993 and August 1993 through discussions with numerous attorneys and by studying the patent and prior art. This 7-month range and general statement is not sufficient to point out specifically how and when this alleged error was discovered.

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As to alleged error C, Applicant has failed to point out exactly when and how this alleged error arose and was discovered (see MPEP 1414 and 37 CFR 1.175). During the prosecution of the original application Applicant was represented by a register patent attorney. It is the duty of a patent attorney to ensure that his applicant receives the broadest patent legally available. Applicant has completely failed to address how and why a registered patent attorney failed to claim all embodiments and versions of the invention disclosed, such that his client would receive the maximum patent protection available.

Applicant asserts that this error was discovered sometime between March 1994 and August 1994, but does not state how it was discovered, only that claims 11-48 where filed because of this alleged error. This 5-mouth range is not sufficient to point out specifically when this alleged error was discovered.

Applicant also asserts that a similar error was discovered during November and December of 1994 and claim 49-56 where filed because of it. Applicant does not specifically point out how this error as discovered and exactly when this error was discovered.

As to alleged error D, Applicant has failed to point out how the failure to use the alternate claim language found in reexamined patent '734 constitutes an error in this application. However, assuming it is an error, Applicant fails to point out how and when this error occurred and was discovered.

As to alleged error E, Applicant has failed to point out how the use of "in response to" instead of "upon receipt of" constitutes an error in this application. Since these phrases mean the

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same thing, the failure to use the alternative is not an error. However, assuming it is an error, Applicant fails to point out how and when this error occurred and was discovered.

Regarding alleged error F, Applicant has state that his patent is partly inoperative or invalid by reason of claiming less than he had a right to. The use of "tuner" for "tuner means", "memory means" for "memory", "operator-actuated control device" for "operator-actuated control means", "processor" for "processor means", "channel code" for "channel tuning designation", "select code" for "channel select designation", and the alternate language wherein \*

\*the "channel tuning designation" is defined as being "in a first series", and the "channel select designation" is defined as being "in a second series", effectively provide for narrower patent coverage. Therefore, the use of these alternative phrases is inconsistent with Applicant's stated reason for filing this reissue and failure to use these alternative phrases in the original application cannot be considered an error as such. However, if the failure to use alternative language is considered an error, Applicant failed to point out exactly how and when the error occurred and has discovered.

Applicant has failed to specify what defects or errors the amendments to the specification found on page 3 of the Substitute Declaration (4-15-95) correct. Use of the term "display code" in the original specification does not appear to be an error. The change of "display code" to "select code" in the above amendment appears to be an attempt to change the nature of the invention, not to correct errors in the original specification.

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In conclusion, Applicant has not pointed out exactly when and how any of the alleged errors occurred and where discovered. Further, Applicant has failed to point out how and why the register patent attorney that handled the prosecution of the original application allowed these errors to occur.

4. Claims 7-19, 21-28 and 30-56 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

5. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

6. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

7. The Examiner has reviewed the prior art submitted by Applicant. Copied of the PTO-1449 form submitted with the forth, fifth and seventh information disclosure statements are attached to this office action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan J. Flynn whose telephone number is (703) 308-6601. The examiner can normally be reached on Tuesday to Friday from 7 a.m. to 5 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John K. Peng, can be reached on (703) 305-4702. The fax phone number for this Group is (703) 305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4702.

Nathan J. Flynn  
Patent Examiner  
March 23, 1997



JOHN K. PENG  
SUPERVISORY PATENT EXAMINER  
GROUP 2600